

Attorney Docket No.: BDA-0038
Inventors: Roger S. Cubicciotti
Serial No.: 09/171,885
Filing Date: October 28, 1998
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Group I, claims 30-31 and 36-40, drawn to a method of making a prodrug complex with combinatorial selection and a prodrug complex made by combinatorial selection;

Group II, claims 32-33, drawn to a method of making a prodrug complex with *in vitro* evolution;

Group III, claims 34-35, drawn to a method of making and administering a prodrug complex; and

Group IV, claim 41, drawn to an immobilized prodrug complex.

The Examiner suggests that the inventions listed as Groups I, II, III and IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical feature. Specifically, the Examiner suggests that the methods of Groups I, II and III do not require the same mode of operation steps and the invention of Group IV is not required to be made by the methods of Groups I, II or III.

Applicant respectfully traverses this Restriction Requirement.

At the outset, Applicant respectfully disagrees with the Examiner's restriction of claims 36-40 only to Group I. Claims 36-40 are multiple dependent claims depending from independent claims 30, 32 and 34. Accordingly, these dependent claims should

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also be included in Groups II and III, at least with respect to the subject matter relating to the independent claims from which they depend. Thus, it is respectfully requested that claims 36-40 also be included in Groups II and III.

Further, Applicant respectfully disagrees with the Examiner that Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 and 13.2. In accordance with MPEP § 1893.03(d), a group of inventions is considered linked to form a general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. The expression special technical feature is defined in MPEP § 1893.03(d) as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art. In the instant application, the special technical feature linking the claims is the ability to produce and administer prodrug complexes by first identifying a drug and then selecting a synthetic receptor that specifically binds the drug. While different steps for selecting the synthetic receptor are set forth in independent claims 30, 32 and 34, as stated in the amendment filed November 2, 2001, this additional language was added at Examiner Ware and Examiner Kishore's suggestion to

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assist Examiner Ware in more effectively searching the instant invention. Claims 30-41, which have now been restricted into 4 separate inventions, are identical to the claims which Applicant faxed to Examiner Ware on August 23, 2001 for consideration. It was Applicant's understanding from subsequent conversations with Examiner Kishore and Examiner Ware (following sending of the claims for review) that these claims provided the detail needed for Examiner Ware to effectively search the claimed invention. No mention of Restriction based upon these new limitations was ever made.

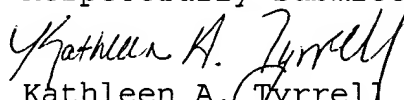
In all fairness to the Applicant, who is a sole inventor with limited resources, and in light of the fact that the claims contain a single general inventive concept under PCT Rule 13.1 and the same or corresponding special technical feature under PCT Rule 13.2, it is requested that this Restriction Requirement be withdrawn.

However, in an earnest effort to be completely responsive, Applicant elects to prosecute Group III, claims 34-35, with traverse.

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Applicant believes that the foregoing comprises a full and complete response to the Office Action of record.

Respectfully submitted,


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